



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/559,499	04/27/2000	Lauri Piikivi	872.0017USU	2125

29683 7590 12/02/2003

HARRINGTON & SMITH, LLP
4 RESEARCH DRIVE
SHELTON, CT 06484-6212

EXAMINER

GARG, YOGESH C

ART UNIT	PAPER NUMBER
----------	--------------

3625

DATE MAILED: 12/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. Box 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 17

Application Number: 09/559,499
Filing Date: April 27, 2000
Appellant(s): PIKIVI ET AL.

MAILED

DEC 02 2003

GROUP 3600

Gerald J. Stanton
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed on 10/16/2003

Art Unit: 3625

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

Art Unit: 3625

(7) Grouping of Claims

As related to issue A, the rejection of claims 1-6, 21, 7, 10-15, 16-20, 22-31 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

6,175,922 B1	WANG	01-2001
6,269,336 b1	LADD ET AL.	07-2001
	(HEREINAFTER, LADD)	
6,256,664 B1	DONOHU ET AL.	07-2001
	(HEREINAFTER, DONOHU).	

Art Unit: 3625

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

The grounds of rejection are reproduced below from the Final Office Action and are provided here for the convenience of both the Appellant and the Board of Patent Appeals:

Appeals:

DETAILED ACTION

Response to Amendment

1. Amendment C, paper # 11, received on 05/06/2003 is acknowledged and entered. Claims 2, 8, 17, and 32 are canceled. Claims 1, 7, 16 and 31 are amended. Currently claims 1, 3-7, 9-16, and 18-32 are pending for examination.

Response to Arguments

2. Applicant's arguments filed on 05/06/2003 with regards to canceled claims 2, 8, 17, amended claims 1, 7, 16, and claims 9 and 22 have been fully considered but they are not persuasive for following reasons:

2.1. In response to applicant's argument that "The Applicant still believes that the claim amendments made in the Response dated 9/6/2003 patently distinguish over Wang" (see Response dated 05/06/2003 page 6), the examiner does not agree as the applicant has not provided any reasoning as how the amendments made in the Response date 9/6/2002 patently distinguish over the rejection of claims 1, 3-7, 10-16, and 18-20 presented in the earlier Office Action, paper # 10, mailed on 03/06/2003.

2.2. In response to applicant's argument that " Wang cannot be modified such that a user PIN number is entered at a mobile station without violating explicit teachings of the reference ", " There appears no motivation within the references to combine the two.....Applicant hereby requests the Examiner reconsider his combination of Wang and Ladd for personal authentication purposes in light of the above ", " Applicant requests the Examiner reconsider his combination of Wang with Ladd and withdraw his rejections based thereon that would otherwise be imputed to claims 1, 7, 9 and 16, as amended herein ", and " As detailed above in the discussion of the combination of Wang with Ladd, Wang teaches away from prompting a user to enter personal authentication information using one of a computer user interface...in claim 22 " (see Response dated 05/06/2003, pages 7 and 8), , the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or

Art Unit: 3625

all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In this case the test for obviousness is not whether the features of Ladd, that is using PIN as an identification tool may be bodily incorporated into the structure of the Wang; nor is it that the claimed invention must be expressly suggested in Wang or Ladd. Rather, the test is that the combined teachings of Wang/Ladd would have suggested the limitations of claims 1, 7, 9 and 16, as analyzed and demonstrated in the earlier Office Action on pages 5-7, and 9 to those of ordinary skill in the art.

Also in response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Wang/Ladd combined teaches the claimed limitations of the amended claims 1, 7, 9, and 16 as analyzed and demonstrated in the earlier Office Action on pages 5-7, and 9.

The applicant is also requested to refer to the following court cases which justify the combination of Wang and Ladd as analyzed and demonstrated in the earlier Office Action on pages 5-7, and 9.

In re Sheckler, 168 USPQ 716 (CCPA 1971)

It is not necessary that a reference actually suggest changes or possible improvements which applicant made.

In re Fine, 5 USPQ2d 1596 (CA FC 1988)

The PTO can satisfy the burden under section 103 to establish a prima facie case of obviousness "by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references."

In re Bozek, 163 USPQ 545 (CCPA 1969)

"Having established that this knowledge was in the art, the examiner could then properly rely, as put forth by the solicitor, on a conclusion of obviousness 'from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference.'"

In re Gershon, Goldberg, and Neiditch, 152 USPQ 602 (CCPA 1967)

"Although references do not disclose or suggest the existence of applicants' problem or its cause, claims are rejected under 35 U.S.C. 103 since references suggest a solution to problem; it is sufficient that references suggest doing what applicants did,

Art Unit: 3625

although they do not teach or suggest exactly why this should be done, other than to obtain the expected superior beneficial results."

In re Beattie, 24 USPQ2d 1040 (CA FC 1992)

"Board of Patent Appeals and Interferences correctly held that it would be obvious to one having ordinary skill in art to combine prior art references in order to arrive at claimed marking system for reading and playing music on keyboard or stringed instruments, despite absence of single express teaching of marking system which combines two musical theories of prior art references, since law of obviousness does not require that references be combined for reasons contemplated by inventor, but only looks to whether some motivation or suggestion to combine references is provided by prior art taken as whole. "

2.2. With regards to the Applicant's arguments, "Additionally, claim 22 For security purposes, a proprietary channel is preferable to publicly known method such as MIME, so Wang's lack of disclosure such as MIME "(see Response page 8), the examiner respectfully disagrees for following reasons:

In response to applicant's argument, that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., " Claim 22 does not require downloading code from a server ...and site to satisfy claim 22, not code as require by Wang ") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Also in response to applicant's argument that "Claim 22 does not require downloading code from a server ...and site to satisfy claim 22, not code as require by Wang "(see Response page 8), a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

2.3. In response to applicant's arguments, regarding claims 23, 30, and 31, " Applicant is unaware of any teaching within Wang that contemplates a list of certificates that are applicable to the transaction requestreconsider and withdraw the novelty rejection of claims 23-31 as amended herein " (see Response page 9), the examiner respectfully disagrees. Wang, see col.15, line 40-col.16, line 67, teaches that during a transaction for purchase of appliances or purchase/sale of securities Wang contemplates using a list of certificates/data/information such as user's signature, user's facial image, finger print, voice print....as unique identifying data to eliminate fraud (see col.16, lines 20-34) and accessible by a mobile terminal that is PEAD in Wang..

2.4. In response to the applicant's arguments regarding rejection of claims 1-6, 21, and 31-32 under USC 112, first paragraph they are persuasive and as such this rejection is withdrawn.

Art Unit: 3625

In view of the foregoing the Prior art rejection of claims 1, 3-7, 9-16, 18-31 is being maintained.

This is a final rejection.

3. **Note:** The prior art rejection of claims 1, 3-7, 9-16, 18-31 is to be viewed in the light of "Response to Arguments" presented above.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:
A person shall be entitled to a patent unless –(e)

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4.1. Claims 23-25, and 28-31 are rejected under 35 U.S.C. 102(e) as being anticipated by Wang.

About claims, 23-25, and 28-31, Wang discloses a method and a system for approving transactions that involves sending a transaction authorization request over a bi-directional link between a vendor server and a portable electronic authorization device such as a cellular phone. A user with an Internet-enabled mobile device such as a cellular phone can contact a merchant's Internet server through a wireless gateway implemented using a short range wireless communication capability such as Bluetooth, and the merchant server can transmit encrypted messages to the user's cellular phone in response via a Requesting Device 202 (FIG.2, which is a computer terminal, see at least col.4, lines 56-61) or 904 (see FIG.9A, col.15, lines 19-40). The user's mobile station can have pre-installed software for performing electronic transaction verification, or the merchant server can download a transaction program TP to the Requesting Device (see col.15, lines 41-col.20, line 43) to enable the electronic transaction. The

Art Unit: 3625

user can generate and send to the remote server user identification and authentication data, such as the user's digital signature, and authorization of the transaction. In response, the merchant site can download authorization confirmation and any electronic tokens required for accessing the service, such as an electronic ticket, to the user's mobile device for future service authorization (see at least Fig. 3A, Fig. 5B, Fig. 7A, Fig. 9A, col. 14 line 63 - col. 15 line 47, col. 16, lines 7 - col. 17 line 19, col. 18, line 33 - col. 19 line 52).

Wang further discloses automatically detecting the presence of a mobile device for user authentication. Wang shows that the transaction program TP downloaded on the requesting device- a computer terminal-between the commerce site server and the mobile station i.e. PEAD-includes an executable program and detects the presence of approval device, if that approval device is embedded or external and further communicates with PEAD-the mobile station-to obtain approval/authentication data (see col.15, line 40-col.16, line 67). Therefore, it is implied that the requesting device, a computer terminal between the commerce site and the mobile station with the help of the Transaction program TP automatically detects the message from the server requesting authentication of the user or requiring other data like user's signature certificate, etc. and communicates with the mobile station -PEAD. This is in line with the rationale used in the application to detect the message from the server and redirect it to the mobile station (see page 4, lines 14-20 and page 5, lines 4-9, where a software module or plug-in the computer PC1 recognizes the message from the server and redirects it to mobile station.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5.1. Claims 1, 3-7, 9-16, and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang in view of Ladd et al. (US 6,269,336), hereinafter referred to as Ladd.

With regards to claims 1, 3-7, 9-16, and 18-20, Wang discloses a method and a system for approving transactions that involves sending a transaction authorization request over a bi-directional link between a vendor server and a portable electronic authorization device such as a cellular phone. A user with an Internet-enabled mobile device such as a cellular phone can contact a merchant's Internet server through a wireless gateway implemented using a short range wireless communication capability such as Bluetooth, and the merchant server can transmit encrypted messages to the user's cellular phone in response via a Requesting Device 202 (FIG.2, which is a computer terminal, see at least col.4, lines 56-61) or 904 (see FIG.9A, col.15, lines 19-40). The user's mobile

Art Unit: 3625

station can have pre-installed software for performing electronic transaction verification, or the merchant server can download a transaction program TP to the Requesting Device (see col.15, lines 41-col.20, line 43) to enable the electronic transaction. The user can generate and send to the remote server user identification and authentication data, such as the user's digital signature, and authorization of the transaction. In response, the merchant site can download authorization confirmation and any electronic tokens required for accessing the service, such as an electronic ticket, to the user's mobile device for future service authorization (see at least Fig. 3A, Fig. 5B, Fig. 7A, Fig. 9A, col. 14 line 63 - col. 15 line 47, col. 16, lines 7 - col. 17 line 19, col. 18, line 33 - col. 19 line 52).

Wang further discloses automatically detecting the presence of a mobile device for user authentication. Wang shows that the transaction program TP downloaded on the requesting device- a computer terminal-between the commerce site server and the mobile station i.e. PEAD-includes an executable program and detects the presence of approval device, if that approval device is embedded or external and further communicates with PEAD-the mobile station-to obtain approval/authentication data (see col.15, line 40-col.16, line 67). Therefore, it is implied that the requesting device, a computer terminal between the commerce site and the mobile station with the help of the Transaction program TP automatically detects the message from the server requesting authentication of the user or requiring other data like user's signature certificate, etc. and communicates with the mobile station -PEAD. This is in line with the rationale used in the application to detect the message from the server and redirect it to the mobile station (see page 4, lines 14-20 and page 5, lines 4-9, where a software module or plug-in the computer PC1 recognizes the message from the server and redirects it to mobile station).

Wang, as discussed above, substantially provides the claimed invention, including entering PIN numbers via a keypad by a user of an ATM for authentication by comparing the PIN with a PIN stored at a remote computer, but fails to provide a user entering a PIN into a mobile station. Ladd teaches a mobile station such as a mobile phone, PDA or pager, that prompts a user to enter a unique PIN for user identification. It would have been obvious to one having ordinary skill in the art at the time of the invention to combine Wang's electronic transaction system with the teaching of Ladd regarding prompting a user to enter a PIN at a mobile station. Doing so would provide a simple means to identify a user and prevent unauthorized use of a mobile station, thus increasing user security.

6. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wang/Ladd in view of Donoho. et al. (US Patent 6,256,664), hereinafter referred to as Donoho.

6.1. With regards to claims 21, Wang/Ladd teaches a method for conducting communication with a commerce related site on Internet as disclosed and analyzed in claims 1 and 23 above. Wang/Ladd does not disclose parsing messages using MIME standard. However, parsing messages using MIME is an old and well-known practice in the field of computer related messaging on Internet as explicitly

Art Unit: 3625

disclosed in Donoho (see at least, col.14, lines 29-49, col.22, line 1-col.31, line 14). Donoho expressly teaches the use of MIME standard and parsing messages to transport files over the Internet. It would have been obvious to a person of an ordinary skill in the art at the time of the invention to modify Wang/Ladd to include the feature of parsing messages and using MIME standard to transport messages/electronic mails/packages over the Internet as explicitly disclosed in Donoho.

7. Claims 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang in view of Donoho. et al. (US Patent 6,256,664), hereinafter referred to as Donoho.

7.1. With regards to claims 26-27, Wang teaches a method for conducting communication with a commerce related site on Internet as disclosed and analyzed in claims 1 and 23 above. Wang does not disclose parsing messages using MIME standard. However, parsing messages using MIME is an old and well-known practice in the field of computer related messaging on Internet as explicitly disclosed in Donoho (see at least, col.14, lines 29-49, col.22, line 1-col.31, line 14). Donoho expressly teaches the use of MIME standard and parsing messages to transport files over the Internet. It would have been obvious to a person of an ordinary skill in the art at the time of the invention to modify Wang to include the feature of parsing messages and using MIME standard to transport messages/electronic mails/packages over the Internet as explicitly disclosed in Donoho.

8. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wang/Ladd in view of Donoho. et al. (US Patent 6,256,664), hereinafter referred to as Donoho.

8.1. With regards to claim 22, all limitations correspond to the limitations of claims 21 and 27, as analyzed and rejected above and therefore the same rationale is used to reject claim 22.

(11) Response to Argument

1. The Appellant remarks on page 6 of the brief that, " *Issue A: Does any combination of references teach or suggest a computer **automatically sending a message to a mobile station in response to receiving a particular message from a commerce-related site or server***". The Appellant repeats the same argument on page 6, lines 16-17, " message be automatically sent to the mobile station when a particular

message from a website is detected”, page 7, lines 12-14, “ *However, Wang does not appear to disclose that the requesting device **automatically send a message** to the PEAD in response to receiving the TP*”, page 8, lines 18-21, “.. *Wang fails to teach or suggest a computer that **automatically sends a message** to a mobile station in response to receiving a message from the website that requires authentication, as recited in varying forms in each of the independent claims* “. The Examiner does not agree with the issue A raised by the Appellant for following reasons:

In response to the Appellant’s argument, it is noted that the feature included in the issue A i.e., “ ***automatically sending a message to a mobile station*** “ **is not recited in the rejected claim(s) 1, 7, 11, 12, 16, 18 and 21 and mentioned under issue A of the Appeal brief on pages 6-9..** Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Note: Claim 1 and all other independent claims merely recite the limitation of sending a message to the mobile station after automatically detecting the presence of the message **but do not claim automatically sending the message to the mobile station.**

The Appellant argues (see page 7, line 15-page 8, line 12) that the Examiner has used the rationale provided by the present invention as motivation to modify the teachings of prior art reference and that prima-facie case for obviousness has not been met. In response, the Examiner would like to point out **that this argument is not relevant** . The limitation “ *in response to automatically detecting the presence of the message, sending a message from the computer to a mobile station over a bi-directional transmission link* “ as recited in claim 1

and also in other independent claims 7, 9, 16, 22, 23, and 31 concerning Issue A has been **rejected as anticipated by Wang** under 35 U.S.C. 102 (e), see the rejection of independent claims 23, 30, 31 on pages 8-9 of the final action reproduced above. While rejecting claims 1, 7, 9, 16 and 22 under U.S.C 103, the limitation related to the issue A was also rejected as being anticipated by Wang as would have been under U.S.C. 102 (e) basis, see final rejection. As regards to the citing of two portions of the present application, it was done to show that the Wang's art (prior art) and the Appellant's specification are similar to each other and there is no mention in the final action of using the appellant's disclosure to reject the limitation of the claims.

The Appellant argues, see page 9, that " neither Ladd nor Donoho teach or suggest a computer automatically sends a message to a mobile station upon detecting the presence of a message from a website that requires authentication, and the Examiner does not contend that either of them do ". In response to the Appellant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., ***automatically sending a message to a mobile station in response to receiving a particular message from a commerce-related site or server***) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Note: Claim 1 and all other independent claims merely recite the limitation of sending a message to the mobile station after automatically detecting the presence of the message **but do not claim automatically sending the message to the mobile**

station and this limitation is anticipated by the reference Wang as analyzed in the final action mentioned above.

With regards to the Appellant's arguments concerning claims 21, see page 9, the Examiner does not agree for the same reasons that is the features upon which applicant relies (i.e., ***automatically sending a message to a mobile station in response to receiving a particular message from a commerce-related site or server***) are not recited in the rejected claim(s) as discussed and analyzed above.

With regards to the Appellant's arguments concerning claims 11 and 12, see page 9, that Wang does not disclose, teach or suggest such a user response comprising a user authentication, a payment request, a digital signature, or any of them, the Examiner does not agree. Wang does disclose that a user response may comprise a user authentication and digital signature (see Wang at least, col.16, lines 20-34, "The executable portion of the TP may also include codes to obtain, through an appropriate input device, **the user's identification for authentication**. By way of example, **the TP may obtain the user's signature**, the user's facial image, finger print, voice print, DNA coding sequence through a tissue sample, or other unique biometrics or other unique identifying data....". Note: The authentication data like digital signature or other data are received from the user stored in PEAD, which is the mobile station). Wang also suggests receiving a payment request from the user (see at least col.15, lines 59-64, "*In return, the TP preferably receives user's data from the user (e.g., the user's identification data, any data which may be required for the proposed transaction such as the address information, quantity information, size information, **method of payment**,*

Art Unit: 3625

credit card number, account number, and the like), and an indication of approval of the transaction.....". Note: Receiving information about method of payment, account information, details of quantity and size of the transaction logically and inherently corresponds to the payment request for the transaction using the details provided for.).

In view of the foregoing and the analysis made above, the Appellant's arguments about the issue A are not persuasive and the rejection of the claims including the limitation " *in response to automatically detecting the presence of the message, sending a message from the computer to a mobile station over a bi-directional transmission link* " is maintained as submitted in the final action.

2. The Appellant remarks, see page 10 of the brief, " *Issue B: Does the Wang reference anticipate a list of certificates as recited in each of claims 23-25 and 28-31*". The Appellant further argues that Wang does not disclose or anticipate a list of certificates from which a user may select, see page 11, lines 10-11, and " *No embodiment anticipates that the user may select from several certificates* ", see page 11, lines 16-17" and have presented similar arguments on pages 12-13 of the brief. The Examiner does not agree with the issue B raised by the Appellant for following reasons:

In response to the Appellant's argument, it is noted that the feature mentioned in the issue B i.e., " ***that the user may select from several certificates***" is not recited in the rejected claim(s) 23-25 and 28-31 and mentioned in the Appeal brief under issue B on pages 10-13. Although the claims are interpreted in light of the

Art Unit: 3625

specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response, **the Examiner would further like to point out that a list of certificates may have only one item listed and not necessarily several items.**

Wang does anticipate disclosing a list of certificates and allowing the user to select one of them, see at least Wang, col.15, line 41-col.17, line 19). In order to carry out a commercial transaction, which could be of any type like purchasing a product, securities, goods or services, documents etc. (see col.15, lines 47-58) a transaction program (TP) is downloaded from a web site on the requesting device, which corresponds to a computer/controller in the claimed invention. TP on the computer receives user's data comprising of user's identification data, authentication data to approve the transaction from a mobile station PEAD (see col.16, lines 7-34). The Examiner broadly interprets the certificates as documents containing information, since the claimed invention has not further narrowed down the description of the term "certificate (s)". The data that can be received from the mobile station includes user's signature, facial image, finger print, DNA coding sequence, unique identifying data (see col.16, lines 20-26), and all this authentic information corresponds to a list of several certificates that are applicable to the request for approval of the transaction . FIG.11 shows "PEAD APPROVAL" which corresponds to disclosing a list of certificates applicable to the request and accessible from the mobile station, i.e. PEAD and the user can select "PEAD APPROVAL" out of the list of certificates presented to the user. Wang further discloses that the requested data (Note: the requested data includes

Art Unit: 3625

certificates for approval and authorization as analyzed above) can be received from PEAD and other sources as well like smart cards or similar apparatus and displayed on the screen providing **choices** to the user to select one of them (see col.17, lines 1-19) to complete the transaction. Presenting the **choices** on the screen to the user to click and select one corresponds to presenting a list of certificates and allowing the user to select one of them.

With regards to the Appellant's arguments concerning claims 26-27 on pages 12-13 since Wang anticipates presenting a list of certificates, as discussed and analyzed above, the rejection of claims 26-27 under 35 U.S.C. 103 (a) as being unpatentable over Wang in view of Donoho is maintained as submitted on page 13 of the final action.

3. The Appellant remarks, see page 13 of the brief, "*Issue C: Can the Wang reference be modified to make obvious that a user authentication message or user personal identification is passed outside a mobile station as recited in claims 1, 10, and 28?*".

In response to the Appellant's argument, it is noted that the limitation, "a user authentication or user personal identification is passed outside a mobile station" is recited in claims 1 and 7 **but not in claim 28**. Claim 28 further limits the independent claim 23 and is directed to prompting the user to enter the personal identical information and verifying it. Nowhere in the claim it is stated that the authentication or user personal identification is passed outside a mobile station. Although the claims are interpreted in

Art Unit: 3625

light of the specification, limitations from the specification are not read into the claims.

See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

With regards to claim 1, the Examiner pointed out in the final action on pages 10- 11 that Wang anticipates the limitation “ in response to receiving the message over the link, generating a user authentication message and passing the user authentication message from the mobile station to the computer over the bi-directional transmission link “, see at least col.16, lines 51-67, and col.5, lines 14-28. Wang teaches that in response to receiving message from the requesting device (which corresponds to the computer terminal in the claimed invention) via the path 206 the PEAD (which corresponds to the mobile station in the claimed invention) and PEAD generates an encrypted authentication message including the transaction approval and the user’s identification data to be transmitted back to the requesting device via path 212. Note paths 206 and 212 correspond to the bi-directional link claimed in the invention.

The claims 1, and 7 (claim 10 is a dependency of claim 7) also recite the limitation that in order to generate a user authentication message a user is prompted to enter PIN and the same is compared with the stored PIN to further pass the authentication message to the computer. The Examiner acknowledged, see page 12 of the final action, that Wang did not expressly disclose prompting the user to enter a PIN into a mobile station and comparing it with the stored PIN in the mobile station before using it to pass the authentication message back to the requesting device/computer. However, in the field of same endeavor that is of accessing information via mobile devices (see col.2, lines 40-58), Ladd teaches prompting the users to enter an unique

Art Unit: 3625

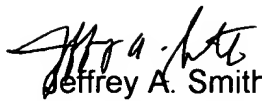
PIN for user identification (see at least col.4, lines 15-18, “ *The system may also identify the user by detecting a unique speech pattern from the user ...or a PIN entered using voice commands or DTMF tones* ”) because to identify the right user and prevent the misuse of the mobile station. In view of the above analysis, the rejection of claims 1, 10, and 28 are maintained.

With regards to the Appellant's arguments, see page 14, lines 6-7, “*the source used to verify the personal identification information in claim 28 is necessarily not within the mobile station*”, this limitation “ necessarily not within the mobile station” is not recited in the claims.

With regards to the Appellant's arguments, see pages 14-16, that Wang's invention teaches away from personal identification and that modifying Wang's invention to incorporate the teachings of Ladd to enter PIN to identify the user are not persuasive in view of the analysis disclosed above. Wang has stated that his invention removes the shortcomings of the prior art by encrypting the transmission of approval and authentication data so that unauthorized users do not intercept this information and thus both the approval and authentication data remain secured (see at least Wang col.5, lines 14-59). Further, Wang does not teach away from using a password to identify the user of the PEAD/mobile station and to prevent the misuse of it (see at least Wang col.11, lines 61-64).


For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted


Jeffrey A. Smith
Primary Examiner
Art Unit 3625

YCG
December 1, 2003

Conferees


Mr. Jeffrey A. Smith
Primary Examiner
Art Unit 3625


Mr. James P. Trammell
Supervisor
Art Unit 3621

Gerald J. Stanton
HARRINGTON & SMITH, LLP
4 RESEARCH DRIVE
SHELTON, CT 06484-6212